



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------------|---------------------|------------------|
| 10/551,989 | 10/04/2005 | Josep Vicent Mercader Badia | 125291 | 6481 |
| 25944 7590 02/18/2009 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850 | | | | |
| EXAMINER | | | | |
| HOBBS, LISA JOE | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1657 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 02/18/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/551,989

Applicant(s)

MERCADER BADIA ET AL.

Examiner

Lisa J. Hobbs

Art Unit

1657

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 February 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-5 and 11.
Claim(s) withdrawn from consideration: 6-10.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached *Information Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Lisa J. Hobbs/
Primary Examiner
Art Unit: 1657

Continuation of 3. NOTE: The amendment will not be entered because it raises new issues, including issues of new matter, that would require further search and consideration.

The amendment to claim 1 is disclosed as incorporating elements from cancelled claim 2 and amended claim 3. However, the language added to claim 1 is not comparable in scope to language in previous claims 2 and 3. Claim 1 now recites that the second container "defines" first volume of air between the second opening of the transfer means and the at least one system for detecting said bacteria, while the language previously in claims 2 and 3 recited that the transfer means comprises at least a first opening in the first container and at least a second opening in the second container (claim 2) and that the second container "delimits" a first volume of air between the second opening and the detection system "and/or" the transfer means delimits a second volume of air between the first opening and the second opening.

The original claim language, supported by the specification, recites that there is an alternative choice between one or two air volumes (and/or) being "delimited"; there is apparently no support for language which limits the air volume to only being between the second opening and the detection system. The previous, supported language recites that the alternative, where two separate air volumes between two parts of the system is contemplated, and neither original claim 2 nor original claim 3 recites only a "defined" single volume of air.

As well, the word change from "delimited" to "defined" must be considered; the specification apparently does not have support for this change.

Continuation of 11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

The request for reconsideration does not overcome the outstanding rejections because it discusses and contemplates specific means for transferring specific volumes of air between sections of the system. It asserts that by adding language specifying that defined amounts of air are transferred between specific sections of the system that transfer of sample could not be reasonably expected to occur. However, one of skill in the art would know, as supported by the cited prior art, that many means of transferring volumes of air, media, sample, etc., are possible in a system such as the one described.

Holbrook et al. disclose tubular carriers allowing motile movement, Taylor et al. disclose thermally controlled movement of sample, and Grant et al. disclose pressure-controlled movement of sample. Also, each of the cited references discloses various open and closed ends allowing movement to be directed and controlled according to the wishes of the operator.